

Page 2 of 5

Response

Serial No.: 09/759,986

Confirmation No.: 3145

Filed: 12 January 2001

For: MULTI-COMPONENT UNIDIRECTIONAL GRAPHIC ARTICLE

and/or use the invention. As support for this enablement rejection the Examiner asserts that the term "scrim" in the specification defines away from the standard definition of scrim.

Applicants respectfully transverse this rejection and submit that the Examiner has failed to meet his burden in establishing a lack of enablement under 35 U.S.C. § 112, first paragraph. The only basis presented for the rejection was Applicants' use of the term "scrim" in connection with the present invention. The Examiner failed to provide any other reasons as to why one of ordinary skill in the art would not be able to make or use the invention without undue experimentation as required for a proper *prima facie* case of non-enablement.

Furthermore, this rejection completely ignores the numerous working examples provided in the specification. "As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied." *MPEP*, § 2164.01(b), p. 2100-180, Version 8, Rev. 1 (Feb. 2003). Applicants note that the term "scrim" is used repeatedly in the examples, thus providing ample guidance as to how to make or use the invention. Applicants respectfully request that, if the rejection is maintained, the Examiner provide some reasoning as to why, in view of the working examples, one of ordinary skill in the art would be unable to make or use the claimed invention without undue experimentation.

For at least these reasons, Applicants submit that claims 1-24 and 31-35 satisfy the enablement requirements of 35 U.S.C. §112, first paragraph. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

Declaration under 37 C.F.R. § 1.132

Applicants submit herewith a second declaration from Sally J. Bull addressing the Examiner's concerns as to how a release liner can be secured to a layer of hot melt adhesive in the absence of a pressure sensitive adhesive.

Page 3 of 5

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Claims 1-24 and 31-35 are rejected under 35 U.S.C. §103(a) as being unpatentable over Andriash (U.S. Patent No. 5,679,435) in view of Bull (WO 97/43128). Applicants traverse this rejection.

The present rejection is premised on the basic assertion that "hot melt adhesive can be and includes pressure sensitive adhesive." *Office Action*, p. 2. No reference is cited in support of this assertion. Pursuant to MPEP § 2144.03, Applicants traverse this assertion and request that the Examiner cite a reference in support thereof. As discussed below, the terms "hot melt adhesive" and "pressure sensitive adhesive" recited in the claims identify different adhesives with different properties.

The Office Action also contains the assertion that "the claims fails [*sic*] to recite that the two adhesives are different." *Office Action*, p. 2. Applicants traverse that assertion, noting that the claims recite that the adhesive on the first surface is a "hot melt adhesive" and the adhesive on the second surface is a "pressure sensitive adhesive." Applicants submit that these recitations alone indicate that the two adhesives are different.

As further support, however, Applicants note that the definition of "pressure sensitive adhesive" is "adhesive that develops maximum bonding power when applied by light pressure only." *McGraw-Hill Dictionary of Scientific and Technical Terms*, (4th Ed. 1989) (copy attached). In other words, pressure sensitive adhesive requires only pressure for adhesion, not heat. In contrast, the specification of the present application notes that a "hot melt adhesive" is "heat activated" (*Specification*, p. 10, ll. 20-24) and the examples teach that the hot melt adhesive is attached to an imaged film using "hot roll lamination" at a temperature of 290° F (*Specification*, p. 18, ll. 8-13). As a result, Applicants submit that one of ordinary skill in the art would know that hot melt adhesives and pressure sensitive adhesives as recited in connection with the present invention are different.

In view of the above, Applicants respectfully submit that the claims as presently pending do recite different adhesives on the opposing surfaces of the scrim layer.

Page 4 of 5

Response

Serial No.: 09/759,986

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In addition, Applicants respectfully submit that the Office Action mischaracterizes the teachings of the Bull reference in that Bull does not teach "a double sided adhesive laminate" as asserted. The Bull reference describes the use of a "scrim liner" to prevent blocking of a hot melt adhesive layer until the article is to be attached to a surface. Nowhere in the Bull reference is the scrim liner described as including a hot melt adhesive on one side and a pressure sensitive adhesive on the other side. Rather, the liner (scrim or otherwise) is used to protect either a layer of pressure sensitive adhesive or a layer of hot melt adhesive - nowhere does Bull teach that a liner would include a hot melt adhesive on one surface and a pressure sensitive adhesive on the other surface.

Although Applicants do not admit that the "scrim liner" of the Bull reference is necessarily porous, Applicants note that even a porous "scrim liner" would at most allow some of the hot melt adhesive (or the pressure sensitive adhesive if used in place of the hot melt) to pass therethrough. The result would be hot melt adhesive (or pressure sensitive adhesive) on both surfaces of the scrim liner - not a hot melt adhesive on one surface and a pressure sensitive adhesive on the other surface as recited in the claims at issue.

For at least the above reasons, Applicants respectfully submit that a *prima facie* case of obviousness is unsupported with respect to claims 1, 8, 16, and 31. Further, claims 2-7, 9-15, 17-24, and 32-35 are nonobvious not only because of their dependence but further because of the distinct features claimed therein. For at least the above reasons, reconsideration and withdrawal of these rejections are respectfully requested.

Page 5 of 5

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It is respectfully submitted that the pending claims 1-24 and 31-35 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
Sally J. BULL et al.

By
Mueting, Raasch & Gebhardt, P.A.
P.O. Box 581415
Minneapolis, MN 55458-1415
Phone: (612) 305-1220
Facsimile: (612) 305-1228

20 MARCH 2003
Date

By: KWRJ
Kevin W. Raasch
Reg. No. 35,651
Direct Dial (612)305-1218

CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on this 20th day of March, 2003 3:38 p.m. (Central Time).

By: Rachael Gebhardt Gebhardt
Name: Rachael Gebhardt Gebhardt